Remarks

Applicants thank Examiner Andrews for his courteous and congenial telephone interview with Applicants' representative on March 25, 2004.

Claims 1-12 and 14-20 are pending in the present application.

Claim 13 is canceled with this Amendment.

Claims 1, 5 and 14 are amended with this Amendment.

Claim 20 is allowed.

Claims 1-19 are rejected.

Claim 1 is amended with this Amendment to more clearly point out and particularly define the invention. The step of rinsing a substrate is included in the claim to further distinguish the invention over the applied documents as was pointed out to the Examiner in the telephone interview. Support in the specification for the rinsing step is at page 6, lines 23-27, and page 10, lines 3-6.

Claim 14 is amended as shown in the Listing of Claims to more clearly point out that the composition containing the catalytic metal colloid is a rinse or dargout bath. Support in the specification for this amendment is at page 6, lines 23-24, page 10, lines 4-6, and page 15, lines 19-21.

Claims 5, 8 and 13 are rejected under 35 U.S.C. §112, second paragraph, as allegedly not particularly pointing out and distinctly claiming the invention.

Claim 13 is canceled. Accordingly, the rejection with respect to this claim is moot.

Claim 5 is amended to recite that the catalytic colloid comprises a catalytic metal and a non-catalytic metal. Support in the specification for this amendment is at page 6, lines 11-15, and at page 8, lines 2-3 and lines 11-23.

Claim 5 now provides sufficient antecedent basis for "the non-catalytic metal" in claim 8, which depends from claim 5.

Applicants respectfully request withdrawal of the rejection of claims 5 and 8 under 35 U.S.C. §112, second paragraph.

Claims 1 to 19 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. 6,267,871 to Weakly et al. in view of U.S. 5,302,183 to DeBoer et al. and U.S. 4,600,699 to Courduvelis. Applicants respectfully traverse this rejection.

As pointed out to the Examiner during the telephone interview Weakly et al. alone or in combination do not teach or suggest a method of recovering a catalytic metal from a catalytic metal colloid containing composition comprising: a) rinsing a substrate of catalytic metal colloid to form a composition comprising the catalytic metal colloid; then b) passing the composition comprising the catalytic metal colloid through a filter to concentrate the catalytic metal colloid on the filter; then c) removing the catalytic metal of the catalytic metal colloid from the filter with an oxidizer; and then d) collecting the catalytic metal. The language of amended claim 1 clearly points out that steps a), b), c), and d) follow in consecutive order without any intervening steps. The term "then" in the language of the claim means that the steps a), b), c) and d) immediately follow each other.

As pointed out in the Office Action at page 3, lines 1-4, Weakly et al. disclose a process with the step of flowing aqueous solutions containing colloidal forms of metals between two electrodes prior to filtering. Weakly et al. require the step of passing solutions with metal colloids through high voltage electric fields prior to collecting the metals on a filter (col. 4, lines 16-23 and lines 51-55, col. 13, lines 57-61, col. 15, lines 36-42, and col. 16, lines 28-44). The presently claimed invention does not pass a composition containing metal colloids through a high voltage electric filed prior to filtering as required in Weakly et al. The method of the presently claimed invention rinses a substrate of catalytic metal colloid then filters.

DeBoer et al. do not make up for the deficiencies of Weakly et al. The presently claimed invention does not include a reduction step as mentioned in the Office Action at page 3. Such a step is not included in the method of the presently claimed invention. DeBoer et al. require a reducing step in their method (col. 3, lines 61-65, col. 4, lines 35-37, and col. 7, lines 22-27). Further, DeBoer et al. remove metals from bleed streams and reaction effluents (col. 2, line 63 to Col. 3, line 3) not rinses from substrates as recited in the present claims.

Weakly et al. and DeBoer et al. require steps absent from the presently claimed method. Accordingly, neither document alone or in combination teaches or suggests the presently claimed invention.

The Office Action does not provide any reasons why Courduvelis renders claims 1-19 unpatentable alone or in combination with Weakly et al. and DeBoer et al. Accordingly, the

Office Action admits that Courduvelis does not teach or suggest the subject matter of claims 1-19.

Applicants respectfully request withdrawal of the rejection of claims 1-19 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. 6,267,871 to Weakly et al. in view of U.S. 5,302,183 to DeBoer et al. and U.S. 4,600,699 to Courduvelis.

Claims 8, 10, 14, and 15 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. 6,267,871 to Weakly et al. in view of U.S. 5,302,183 to DeBoer et al. as applied to claim 1 above, and further in view of U.S. 4,600,699 to Courduvelis. Applicants respectfully traverse this rejection.

Present claim 1 would not have been obvious in view of Weakly et al. alone or in combination with DeBoer et al. for the reasons discussed above.

Courduvelis does not make up for the deficiencies of Weakly et al. and DeBoer et al. As admitted in the Office Action Courduvelis does not teach or suggest the subject matter of at least present claim 1. Since claims 8, 10, 14, and 15 depend directly or indirectly from independent claim 1, they would not have been obvious in view of Courduvelis.

Applicants respectfully request withdrawal of the rejection of claims 8, 10, 14 and 15 under 35 U.S.C. §103(a) over U.S. 6,267,871 to Weakly et al. in view of U.S. 5,302,183 to DeBoer et al. as applied to claim 1, and further in view of U.S. 4,600,699 to Courduvelis.

Claims 1, 16 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1 to 20 of co-pending patent application No. 10/301,075.

Applicants disagree with the Office Actions allegation, however, to expedite allowance of the present application enclosed is a terminal disclaimer to over come the rejection.

Applicants respectfully request withdrawal of the provisional rejection of claims 1, 16, and 19 under the judicially created doctrine of obviousness-type double patenting in view of co-pending patent application No. 10/301,075.

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims of the co-pending application No. 10/301,367.

Applicants disagree with the Office Actions allegation, however, to expedite allowance of the present application Applicants include a terminal disclaimer to over come this rejection.

Applicants respectfully request withdrawal of the provisional rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting over application No. 10/301,367.

Favorable consideration and allowance of claims 1-12 and 14-19 are earnestly solicited.

Should the Examiner have any questions concerning this Amendment or this application, or should he believe this application is for any reason not yet in condition for allowance, he is respectfully requested to telephone the undersigned at the number set forth below in order to expedite allowance of this application.

Respectfully submitted,

John Piskorski

John J. Piskorski
Attorney for Applicant
Registration No. 35,647
Telephone No.: (508) 229-7662
Facsimile No.: (508) 787-4730

Rohm and Haas Electronic Materials
455 Forest Street
Marlborough, Massachusetts 01752